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**Remarks**

Entry of the above-noted amendments, reconsideration of the application, and allowance of all claims pending are respectfully requested. Claims 1-10 are pending.

Applicant's arguments presented below focus on certain patentable differences between the invention as claimed and the applied references. However, it is not to be inferred that the failure to argue all differences between the claimed subject matter and the applied references constitutes acceptance of assertions made in the Office Action of alleged similarities between elements of the claimed subject matter and the applied references.

**Claim Rejections - 35 U.S.C. §103**

All claims were rejected under 35 U.S.C. §103 as being unpatentable over Wengrovitz (U.S. Patent No. 6,909,778) in view of Morganstein (U.S. Patent No. 5,940,476). This rejection is respectfully traversed.

MPEP §706.02(j) states: "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." (Emphasis added.)

**Claim 1**

Claim 1 is directed to the method for providing Internet protocol telephone set subscribers with call features provided by a public switched telephone network (PSTN) switch. A packet is

received at the IP peripheral unit which is part of the PSTN switch where the packet contains a request for a first call feature. The IP peripheral unit transmits a second message to a packet line trunk unit of a switch module of the PSTN switch where the second message contains the request for the first call feature. An applications processor contained in the PSTN switch accesses first information contained in a directory database based on the request of the first call feature of the second message. The applications processor retrieves at least a portion of the first information. The PSTN switch transmits the at least portion of the first information to an IP telephone set subscriber in response to the request for the first call feature.

An important consideration in accordance with the invention of claim 1 is that the PSTN switch itself provides call features to IP telephone set subscribers. As explained in the Background of the subject application, it is believed that prior to the subject invention a full array of call features was not available to IP telephone set subscribers even from an IP PBX. One reason why such services were not available is that an IP PBX was unable to communicate with the applications processor of the supporting PSTN switch, whereby call processing services only available through the applications processor/PSTN switch could not be accessed by IP telephone set subscribers. Wengrovitz, Morganstein, or the combination thereof do not teach the steps required accordance claim 1 or provide the advantage of providing direct support to IP telephone set subscribers from a PSTN switch.

Wengrovitz is directed to IP phone operation using the architecture as shown in its FIG. 2. An IP phone client 30 utilizes an IP network based server 38 that interacts with the subscriber phone and PBX 36 also connected to the IP network. This arrangement is similar to that described in the Background of the subject application in that services provided by an IP capable PBX are available to the IP telephone subscriber, but services that are only available through the PSTN switch still remained not available to the IP telephone subscriber. The architectures shown in FIG. 4 and 6 of Wengrovitz suffer from the same problem explained with regard to the architecture of FIG. 2.

Morganstein is directed to techniques associated with identifying an unidentified caller. It is important to note that network 12 of Morganstein FIG. 1 is the PSTN and that the "switch" 20 is

the organization's telephone switching system, i.e. a PBX; see column 2, lines 35-57. Although the block diagram of FIG. 1 of Morganstein initially appears to be significantly different from the block diagrams of Wengrovitz, the architecture of Morganstein and Wengrovitz are very similar with regard to relevancy to be present invention. In Morganstein, the PBX 20 is coupled to a server 30 which is in turn coupled to a database server 34. It will be noted that PBX 20, server 30 and database server 34 are all part of the data communication system 10 utilized in Morganstein. It would be clear to one of ordinary skill the art that the actions associated with these elements are not part of the PSTN 12, and are certainly not part of a PSTN switch.

The method of claim 1 implemented by the PSTN switch is not taught by Wengrovitz, Morganstein or the combination thereof. For example, neither Wengrovitz nor Morganstein teach or suggest how call features provided by a PSTN switch can be obtained by an IP telephone set subscriber. Both applied references relate to services provided by a PBX to subscribers coupled to the PBX. In this regard, neither reference is more relevant than the previous technology discussed in the Background of the subject application.

The rejection of claim 1 under 35 U.S.C. 103 based on Wengrovitz in view of Morganstein is requested to be withdrawn.

For similar reasons discussed above with regard to claim 1, the rejection of independent claim 6 under 35 U.S.C. 103 also based on Wengrovitz in view of Morganstein should be withdrawn.

#### **Prior art teaches away**

It is well-settled that teachings of a reference that teach away from a limitation of the claimed invention must be considered as well as teachings of the reference that could point towards the invention.

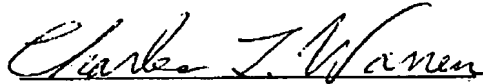
...an applicant may rebut a prima facie case of obviousness by showing that the prior art teaches away from the claimed invention in any material respect. *In re Geisler*, 116 F.3d at 1469, 43 USPQ2d at 1365 (quoting *In re Malagari*, 499 F.2d

at 1303, 182 USPQ at 553). *In re Peterson*, 315 F.3d 1325, 65 USPQ2d 1379 (CA FC 2003)

Both Wengrovitz and Morganstein teach away from the present invention of claim 1 and 6 in a material respect, i.e. both suggest that a PBX is the provider of services to subscribers. This prevents services available only through a PSTN switch from being provided to IP phone set subscribers. Hence, the prima facie case of obviousness made in the Office Action is rebutted and should be withdrawn.

In view of the above amendments and remarks, allowance of all claims pending is respectfully requested. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicants' attorney.

Respectfully submitted,



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